

REMARKS/ARGUMENTS

Claims 1, 3, 5 through 7, 10 through 15, 20 through 24, and 26 through 30 are pending in the application. Claims 2, 4, 8, 9, 16 through 19, and 25, were canceled by previous amendment. The previously-indicated allowability of claims 26 and 27 was withdrawn by the Examiner in the most recent Office Action. However, for at least the reasons set forth below, Applicants respectfully submit that Claims 1, 3, 5 through 7, 10 through 15, 20 through 24, and 26 through 30 are allowable over the art of record.

Claims 1, 3, 5 through 7, 10 through 15, 20 through 24, and 26 through 30 stand rejected under the judicially-created doctrine of obviousness-type double patenting over claims 1 through 13 of U.S. Patent No. 6,635,205 to Williams et al. (Williams).

Claims 1 through 13 in Williams are each directed to a *method of manufacturing* a catamenial/tampon product. As an example, claim 1 in Williams recites the following:

Claim 1: A method of manufacturing a catamenial/tampon product comprising the steps of (a) forming a plurality of fibers and, during the process of forming, incorporating in the fibers one or more naturally sourced odor adsorbent materials selected from the group consisting of: glycerin, glycerin compound, aldehyde, natural oil, solution of soluble natural compound, natural plant and herb extract, naturally occurring deodorizing active, acid, base, oxidant, chelating agent, ester, masking agent, sensory receptor alterant, oxidizing agent, biological agent, surfactant, surface-active polymer, and any mixtures thereof; and (b) forming the plurality of fibers into the catamenial/tampon product.

Likewise, the other two independent claims in Williams (claim 3 and claim 10) recite a method of manufacturing a catamenial/tampon product. The dependent claims in Williams (claims 2, 4 through 9, 11, and 12) recite further limitations to a method of manufacturing a catamenial/tampon product. In addition, none of the claims in Williams is directed to a *method of using* the catamenial/tampon product (such as “method of deodorizing a vaginal area,” as recited in claims 24, 26 and 27 of the present application).

Claim 1 of the present application recites a tampon for absorbing body fluids. The tampon has one or more malodor counteractant materials, in liquid form, present between about 0.01 grams to about 50% of the total weight of the tampon. The malodor counteractant materials are selected from glycerin, glycerin compound, aldehyde, natural oil, solution of soluble natural compound, natural plant and herb extract, naturally occurring deodorizing active, citric acid, acetic acid, base, EDTA, ester, masking agent, sensory receptor alterant, oxidizing agent, biological agent, surfactant, surface active polymer, and any mixtures of these, but not including ascorbic acid or its derivatives. Claims 3 and 5 depend from claim 1.

Claim 6 recites a tampon for absorbing body fluids. The tampon has glycerin present between about 0.01 grams to about 50% of the total weight of the tampon. The glycerin is naturally sourced. Claims 7 and 10 depend from claim 6.

Claim 11 recites a tampon for absorbing body fluids. The tampon has thereon a malodor counteractant material comprising glycerin, and at least one additional malodor counteractant material selected from aldehyde, natural oil, solution of soluble natural compound, natural plant and herb extract, naturally occurring deodorizing active, citric acid, base, EDTA, ester, masking agent, sensory receptor alterant, oxidizing agent, biological agent, surfactant, surface active polymer, zeolite, and any mixtures thereof. Claims 12 through 15 depend from claim 11.

Claim 20 recites a tampon for absorbing body fluids. The tampon has a fibrous material for absorbing the body fluids and a liquid glycerin that does not support microbial growth disposed in the tampon to absorb odors associated with the body fluids. Claims 21 through 23 depend from claim 20.

Claim 24 recites a method of deodorizing a vaginal area comprising applying the tampon of claim 1 to the vaginal area, wherein the one or more malodor counteractant materials counteracts malodor in the vaginal area.

Claim 26 recites a method of deodorizing a vaginal area comprising applying to the vaginal area a fibrous absorbent article having thereon a malodor counteractant material comprising glycerin and at least one additional malodor counteractant material selected from aldehyde, natural oil, solution of soluble

natural compound, natural plant and herb extract, naturally occurring deodorizing active, citric acid, base, EDTA, ester, masking agent, sensory receptor alterant, oxidizing agent, biological agent, surfactant, surface active polymer, zeolite, and any mixtures thereof, wherein the glycerin and the additional malodor counteractant materials counteract malodor in the vaginal area.

Claim 27 recites a method of deodorizing a vaginal area comprising applying to the vaginal area a fibrous absorbent article having a fibrous material suitable for absorbing body fluids and a liquid glycerin that does not support microbial growth disposed in the fibrous material, to counteract malodor in the vaginal area. The liquid glycerin is present between about 0.01 grams to about 50% of the total weight of the fibrous absorbent article.

Claim 28 recites a fibrous absorbent article for absorbing body fluids. The fibrous absorbent article has one or more malodor counteractant materials, in liquid form, selected from aldehyde, natural oil, solution of soluble natural compound, natural plant and herb extract, naturally occurring deodorizing active, ester, sensory receptor alterant, oxidizing agent, biological agent, surfactant, surface active polymer, and any mixtures of these, but not including ascorbic acid or its derivatives. Claims 29 and 30 depend from claim 28.

The rule for the determination of double patenting is a two-part test: (1) is the same invention being claimed twice?; and (2) does any claim define merely

an obvious variation of an invention disclosed and claimed in the patent? *In re Vogel and Vogel*, 422 F.2d 438; 164 USPQ 619, 621-622 (CCPA 1970). If the answer to both questions is no, there is no double patenting. *Id.* at p. 622.

As can be seen from the comparison of the claims in Williams with those in the present application, claims 1, 3, 5 through 7, 10 through 15, 20 through 24, and 26 through 30 of the present application are patentably distinct from claims 1 through 13 in Williams. Each of claims 1 through 13 of Williams recites a *method of manufacturing* a catamenial/tampon product by forming a plurality of fibers into a catamenial/tampon product and incorporating odor-absorbent materials in the fibers during the forming process. By contrast, claims 1, 3, 5 through 7, 10 through 15, 20 through 24, and 26 through 30 of the present application recite a tampon or fibrous absorbent article for absorbing body fluids, and a method of deodorizing a vaginal area. As any of the claims for Williams could be literally infringed without literally infringing on any of the claims of the present application, the claims do not represent the same invention. See *Vogel* at p. 622 (providing an objective test for "same invention"). As can be seen from the comparison of claims above, the claims in the present application are not merely obvious variations of the claims in Williams. Thus there is no double patenting of the claims in the present application.

Further, claims 1, 3, 5, 6, 7, 10, 24, 27, 29 and 30 of the present application recite a specific limitation governing the amount (or percent of total

weight) of the malodor counteractant materials present in the tampon or fibrous absorbent article. This limitation is not present in any of claims 1 through 13 in Williams, and thus these claims are further patentably distinguishable from Williams for this additional reason.

For at least the above reasons, Applicants submit that there is no double patenting with claims 1 through 13 in Williams, and respectfully request reconsideration and withdrawal of the double patenting rejections brought over Williams to claims 1, 3, 5 through 7, 10 through 15, 20 through 24, and 26 through 30.

Claims 1, 3, 5 through 7, 10 through 15, 20 through 24, and 26 through 30 stand rejected under 35 U.S.C. §103(a) over U.S. Patent No. 5,417,224 to Petrus et al. (Petrus).

Petrus describes a tampon having one or more cords shaped into a loop placed through the body of the tampon, to assist in insertion and removal from the body cavity. Petrus further describes a tampon impregnated with spermicides, anti-infectives, anti-fungals, anti-virals, hormones, amino acids and/or anti-oxidants (col. 3, lines 5 – 11; col. 1, lines 7 – 10; and col. 3, lines 2 – 5). Petrus also describes a combination of the medications described above and lubricants/moisturizers to be placed “on only the outer region (22)” of the tampon.

Petrus describes examples of lubricants for vaginal dryness such as glycerin, sorbic acid, and mineral oil (col. 6, lines 37 – 43).

Independent claims 1, 6, 11, 20, 24, 26, 27 and 28 of the present application are summarized above.

The Office Action (page 4, lines 5 – 6) states that glycerin, while disclosed in Petrus as a lubricant, was additionally able to absorb odors, as taught by U.S. Patent No. 4,880,417 to Yabrov et al. Although the Office Action acknowledges that Petrus is “silent on the claimed about [sic] of malodor counteractant material present in the absorbent” (page 4, line 7), the Office Action asserts that Petrus discloses a malodor counteractant in a tampon (col. 6, lines 49 – 51). The Office Action concluded that the “general conditions of the claims are disclosed,” and that claims 1, 3, 5 through 7, 10 through 13, 15, 20 through 24, and 26 through 30 are thereby rendered obvious over Petrus (page 4, lines 1 – 2; lines 9 – 10).

Applicants respectfully submit that the Office Action fails to make a *prima facie* case of obviousness. The following criteria must be met to establish a *prima facie* case of obviousness. First, the prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion of incentive that would have motivated the skilled artisan to modify a reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference, or

combination of references, must teach or suggest all of the claimed limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

As noted above, the novel feature of Petrus is a tampon having a cord shaped into a loop that passes through the body of the tampon for easier insertion and removal from the body cavity, impregnated with spermicidal, anti-bacterial, anti-viral or anti-fungal medications, among others (col. 3, lines 5 – 11; col. 1, lines 7 – 10; and col. 3, lines 2 - 5), and having a lubricant/moisturizer added to only an outer layer of the tampon (col. 6, lines 37 – 43; col. 3, lines 26 - 29). Petrus emphasizes that "sonic placement of the lubricant *within only the outer region* [of the tampon]" [emphasis added] would ensure that the porous material of the tampon would be fully sealed within the body cavity (col. 7, lines 2 – 5).

By contrast, claim 1 of the present application recites a tampon having one or more malodor counteractant materials (selected from a group including glycerin) which are present throughout the tampon in amounts between about 0.01 grams to about 50% of the total weight of the tampon. The Office Action does not provide a rationale why the person of skill in the art, at the time of this application, would be motivated to modify the teaching of Petrus to use glycerin

as a malodor counteractant throughout the tampon, particularly in view of the fact that Petrus emphasized the advantage of having glycerin or mineral oil (as lubricants) only on the outer layer or region (22) of the tampon (col. 6, lines 37 – 42; col. 3, lines 26 - 29). See MPEP 2144.05 (a *prima facie* case of obviousness may be rebutted by showing that the art, in any material respect, teaches away from the claimed invention).

Likewise, claims 3, 5, 6, 7, 10 through 15, 20 through 23, and 28 through 30 recite, in relevant part, a tampon or a fibrous absorbent article having one or more malodor counteractant materials which are not limited to placement on (or within) the outer layer or region of the tampon, as Petrus had described for glycerin in the cited reference. In addition, claims 24, 26, and 27 recite a method of deodorizing a vaginal area with a tampon or fibrous absorbent article having malodor counteractant materials that are not limited to placement on (or within) the outer layer or region of the tampon or fibrous absorbent article. The Office Action fails to provide a rationale why the person of skill in the art, at the time of this application, would have been motivated to modify the teaching of Petrus in such a manner as to render obvious these claims, particularly in view of the fact that Petrus emphasized the advantage of using glycerin or mineral oil as lubricants only on the outer layer or region (22) of the tampon (col. 6, lines 37 – 42) (col. 3, lines 26 – 29). See MPEP 2144.05, *supra*.

Further, the Office Action states that Petrus discloses pectin as a malodor counteractant at col. 6, lines 37 – 52. The Office Action acknowledges that Petrus is “silent” on the claimed *amount* of counteractant material present in the tampon (Office Action at page 4, lines 4 – 7). The Office Action concludes that this description of a malodor counteractant in a tampon discloses the “general conditions” of the claims, and thus the aforementioned claims would have been obvious because “where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.” *citing In re Aller*, 105 USPQ 233 (CCPA 1955).

Again, Applicants respectfully submit that the Office Action fails to make a *prima facie* case of obviousness. The facts of the present application are readily distinguishable from the facts in *In re Aller*. In *Aller*, the claimed process was identical to that of the prior art, except that applicants’ claims specified lower temperatures and higher sulphuric acid concentrations than shown in the reference. *In re Aller*, 105 USPQ at p. 234. Specifically, Applicants’ process was claimed at temperatures between 40°C and 80°C, and sulphuric acid concentrations between 25% and 70%, as compared with the prior reference showing the process was conducted at 100°C and at a sulphuric acid concentration of 10%. *Id.*; see also MPEP 2144.05(II)(A), *citing in re Peterson*, 65 USPQ2d 1379, 1382 (Fed. Cir. 2003)(“the normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum

combination of percentages”). It can readily be seen that the prior reference in this case, Petrus, is distinguishable from *Aller* or *Peterson* in that Petrus described addition of a deodorant to the tampon in general terms, but did not claim or even describe a specific amount or preferred range of deodorant. Contrary to the Office Action's inference that the claimed amounts of malodor counteractant are an obvious matter, Applicants respectfully submit that the use of the specific amounts and ranges of malodor counteractant materials in the tampon or fibrous absorbent article in the present invention is not arbitrary. As disclosed on pages 18 – 19 of the present application, in conjunction with Figures 2 and 3, the use of malodor counteractant in the claimed amount produces a tampon or fibrous absorbent article having exceptional malodor counteractant ability. The Office Action thus fails to describe a motivation for one of skill in the art, at the time of the application, to have selected the particular types and/or amounts of malodor counteractant materials, as recited in claims 1, 3, 5, 6, 7, 10, 24, 27, 29 and 30.

The Office Action separately addresses dependent claim 14, asserting that Petrus discloses that “the fragrance was in liquid form” at col. 7, lines 60 – 67. However, at col. 7, Petrus references a sonic bath (Figure 5) in which a tampon (10) can be selectively impregnated with various fluids in solution (32). Petrus describes this technique to impregnate the tampon with a “spermicide, anti-infective, anti-viral, anti-fungal, etc.,” each of which would be an active agent within the catamenial/tampon product. Petrus does not expressly disclose a

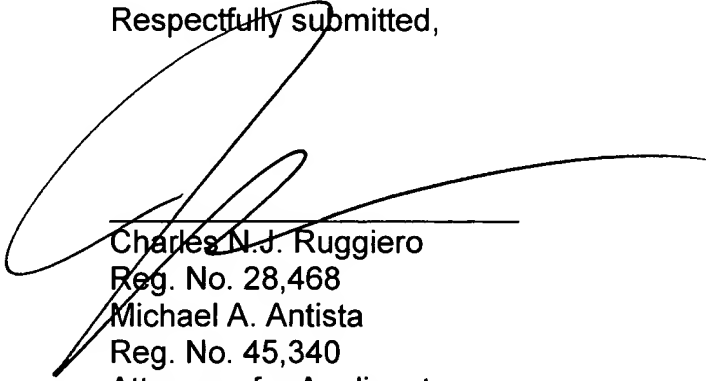
liquid fragrance at this citation, and the Office Action provided no statement why the person of ordinary skill in the art would presume that a fragrance would necessarily be in liquid form because of this description in the reference.

Therefore, for at least the above reasons, it is respectfully submitted that the Office Action fails to make a *prima facie* case of obviousness for claims 1, 3, 5 through 7, 10 through 15, 20 through 24, and 26 through 30. Applicants submit that claims 1, 3, 5 through 7, 10 through 15, 20 through 24, and 26 through 30 are patentably distinguishable over Petrus. Therefore, Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. §103(a) rejection of claims 1, 3, 5 through 7, 10 through 15, 20 through 24, and 26 through 30.

Applicants maintain that claims 1, 3, 5 through 7, 10 through 15, 20 through 24, and 26 through 30 are patentably distinguishable over the cited art. As such, reconsideration and withdrawal of the above rejections and passage of this application to allowance is respectfully requested.

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Respectfully submitted,



Charles N.J. Ruggiero
Reg. No. 28,468
Michael A. Antista
Reg. No. 45,340
Attorneys for Applicants
Ohlandt, Greeley, Ruggiero & Perle, LLP